ESTTA Tracking number:

ESTTA1031696

Filing date:

01/27/2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	M2BPens Florida IIc
Granted to Date of previous extension	01/25/2020
Address	20355 NE 34 CT, 227 AVENTURA, FL 33180 UNITED STATES

Attorney information	KAUSTUBH NADKARNI NADKARNI LAW 1900 N. BAYSHORE DRIVE UNIT 1A, STE 140 MIAMI, FL 33132 UNITED STATES ip@nadkarnilaw.com 7863001227
----------------------	--

Applicant Information

Application No	79247573 Publication date 11/26/2019		11/26/2019
Opposition Filing Date	01/27/2020	Opposition Peri- od Ends	01/25/2020
International Registration No.	1439398	International Registration Date	06/28/2018
Applicant	Ispira srl Via Piave, 205 Napoli, I-80126 ITALY		

Goods/Services Affected by Opposition

Class 016. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Writing cases, being stationery; drawing pads; inkwells; pen clips; cabinets for stationery being office requisites; staples for offices; rubber erasers; ink; Indian inks; pastels, namely, crayons; nibs; nibs of gold; pens being office requisites; paperweights; balls for ball-point pens; steel pens; penholders; pen cases; erasing products; writing or drawing books; inkstands; fountain pens; note books

Grounds for Opposition

The mark is merely descriptive	Trademark Act Section 2(e)(1)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)

False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Misuse of Registration symbol	Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991)

Exhibit C.pdf(60397 bytes) Exhibit D.pdf(72716 bytes) Exhibit E.pdf(3430294 bytes)	Attachments	Exhibit D.pdf(72716 bytes)
--	-------------	-----------------------------

Signature	/Kaustubh Nadkarni/
Name	Kaustubh Nadkarni
Date	01/27/2020

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application No. 79/247,573		
By: M2B Pens Florida LLC		
For the Mark: LEONARDO OFFICINA ITALIAN	NA	
M2B PENS FLORIDA LLC,)	
Opposer,)	
v.)	Opposition No.
ISPIRA SRL SOCIETÀ A RESPONSABILITÀ)	
LIMITATA (SRL))	
Applicant.)	
)	

NOTICE OF OPPOSITION

M2B PENS FLORIDA LLC ("M2B Pens" Or "Opposer"), a Florida limited liability company moves the Trademark Trial and Appeal Board ("Board") for an order opposing the registration of Application No. 79/247,573 for the trademark LEONARDO OFFICINA ITALIANA ("Applicant's Applied-For Mark") filed by the Applicant Ispira Srl Società A Responsabilità Limitata (Srl) ("ISPIRA SRL") on the grounds that Applicant's Applied-For Mark, when used on or in connection with some of Applicant's goods is merely descriptive in relation to Applicant's goods; Applicant's Applied For Mark has a false suggestion of a connection with

persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute; and Applicant's Applied For Mark is legally abandoned due to non-use of all of its identified goods with interstate commerce between Italy and the United States, or at least sufficient to show interstate commerce use for an in-commercial use mark under the applicable rules.

I. STANDING

- 1. Opposer has standing to argue that the portion of the mark is merely descriptive under *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1768 (TTAB 2007) and *Monetecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060 (TTAB 2010).
- 2. Opposer also has standing under *Bankamerica Corp v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987) on the grounds that the entire mark is has been abandoned. See TBMP 309.03(b).
- 3. Opposer has standing to argue under *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385 (TTAB 1991) on the basis that Opposer is not required to allege proprietary rights in the name Leonardo for standing purposes and *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir.1983) on the basis that Applicant's Mark or portion of Applicant's Applied-For Mark has no connection with Leonardo Da Vinci, a famous Italian polymath, or that Applicant's goods are actually made in Leonardo Da Vinci's Italian Workshop.
- 4. Opposer has standing to argue that Applicant is seeking registration fraudulently under *Bose Corp. v. Hexawave, Inc.*, Opposition No. 91157315, 2008 WL 1741913 (T.T.A.B. Apr. 9, 2008) on the basis that a third party may petition to oppose a trademark on the ground that the registration is being obtained fraudulently. 15 U.S.C. § 1064(3).

5. Opposer has standing to argue that Applicant is misusing the Applied-For Mark Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991).

FIRST CLAIM OF RELIEF UNDER LANHAM ACT 2(E)

II. LEONARDO OFFICINA ITALIANA IS MERELY DESCRIPTIVE IN RELATION TO THE GOODS THAT APPLICANT ALLEGEDLY PROVIDES.

- 6. The term LEONARDO OFFICINA ITALIANA is a merely descriptive term. It simply means Leonardo['s] Italian Workshop. Allowing Applicant to continue having exclusive rights to the term LEONARDO OFFICINA ITALIANA would be a violation of the most basic principles of trademark law given that the terms merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services, and thus are unregistrable components of the Applicant's Applied For Mark. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).
- 7. More specifically, on December 20, 2018, the USPTO issued an office action in relation to Applicant's Applied-For trademark. **Exhibit A**. In the office action, the Examining Attorney, Mr. John M. Wilke rightfully required a disclaimer from the Applicant on the basis that the Italian term OFFICINA simply means "workshop" in English and that the term is commonly used in connection with office goods. Furthermore, the Examining Attorney also correctly required a disclaimer from the Applicant for the term ITALIANA. The term ITALIANA meaning "Italian" is a primarily geographically descriptive of the origin of Applicant's goods. **Exhibit A**.
- 8. On October 4, 2019, after reviving Applicant's application after a notice to revive application was issued, Applicant accepted the disclaimers from the Examining Attorney on the basis of their descriptiveness. **Exhibit B**.

- 9. Opposer asserts that the term LEONARDO is also descriptive in relation to Applicant's goods. Leonardo is the name of a famous Italian polymath, Leonardo Da Vinci. He is well known all over the world. Collectively, Applicant's Applied-For trademark LEONARDO OFFICINA ITALIAN means nothing more than Leonardo['s] Italian Workshop, and again, merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods, and are thus, unregistrable components of the Applicant's Applied for Mark. **Exhibit C.**
- 10. Allowing Applicant to register Applicant's Applied-For Mark on the principal register would be akin to allowing General Mills' exclusive rights to CALORIC SUBSTANCES as a trademark for food products.
- 11. Thus, Applicant's Applied-For Mark is merely descriptive in violation of Lanham Act 2(E) and is not entitled to registration and is subject to opposition.

SECOND CLAIM OF RELIEF UNDER LANHAM ACT 2(A)

III.LEONARDO OFFICINA ITALIANA IS A FALSE SUGGESTION OF A CONNECTION WITH PERSONS, LIVING OR DEAD, INSTITUTIONS, BELIEFS, OR NATIONAL SYMBOLS, OR BRINGS THEM INTO CONTEMPT, OR DISREPUTE

12. Leonardo da Vinci is an Italian painter, draftsman, sculptor, architect, and engineer whose genius, perhaps more than that of any other figure, epitomized the Renaissance humanist ideal. His works like the Last Supper and Mona Lisa are among the most widely revered, popular and influential paintings. His writings reveal a spirit of scientific inquiry and a mechanical ingenuity that were centuries ahead of their time, not only in Italy, but also worldwide. The name LEONARDO has become closely associated with Leonardo Da Vinci in the minds of the purchasing public, and furthermore, given that Applicant originates from Italy and Applicant's goods are allegedly made in Italy.

13. Applicant's adoption of the name LEONARDO in Applicant's Applied-For Mark in relation to Applicant's identified office goods is with the intent to falsely suggest a connection with the famous Italian Leonardo Da Vinci, and that the purchasers would be likely to assume that Leonardo Da Vinci or his estate sponsors or in some way is associated with Applicant's office goods, or Leonardo Da Vinci's Italian workshop is where Applicant allegedly makes its identified office goods.

14. Thus, Applicant's Applied-For Mark falsely suggests a connection with a famous person, in violation of Lanham Act 2(A), and is not entitled to registration and is subject to opposition.

THIRD CLAIM OF RELIEF UNDER LANHAM ACT 1(A) and 1(C)

IV.LEONARDO OFFICINA ITALIANA IS NOT USED WITHIN INTERSTATE COMMERCE BEFORE THE FEDERAL APPLICATION WAS FILED WITH THE USPTO AND NO AMENDMENT TO ALLEGE USE WAS FILED

15. On December 13, 2018 Applicant submitted Applicant's federal trademark application with the USPTO. **Exhibit D**. Upon information and belief, Applicant is not continuously using the Applicant's Applied-For Trademark in relation to all of its identified goods within interstate commerce between Italy and the United States, or at least sufficient to satisfy interstate commerce use to generate sales for an in-commercial use trademark under the applicable requirements of the USPTO.

16. Applicant's non-use of all of its identified goods within interstate commerce before the application was filed with the USPTO can be determined by Opposer via discovery.

17. There is also a plurality of evidence that proves that Applicant may not be using Applicant's Applicant's Applicant's Submitted Application Serial No. 79/247,573 with the United States Patent and Trademark Office (USPTO). **Exhibit E.**

- 18. As it can be seen, Applicant is not using the Applicant's Applied-For Mark within commerce in accordance to Applicant's application serial no. 79/247,573. Applicant's alleged use of Applicant's Mark on the container in **Exhibit E** is vastly dissimilar to how Applicant has submitted Applicant's Applied-For Mark in its Application Serial No. 79/247,573 with the USPTO.
- 19. First, the design element of "wings" found on the packaging in **Exhibit E** are incorrectly used. Second, the literal terms are also incorrectly positioned, wherein the term LEONARDO is not in a superimposed position as depicted in Application Serial No. 79/247,573 with the USPTO.
- 20. Therefore, and as evidence suggests, Applicant's Applied-For Mark is not used within commerce as submitted in Applicant's Application Serial No. 79/246,573.
- 21. By reasons of the foregoing, Opposer is likely to be harmed by the registration of Application Serial No. 79/247,573 for Applicant's Applied-For Mark LEONARDO OFFICINA ITALIANA.

FOURTH CLAIM OF RELIEF UNDER LANHAM ACT 1(A) and 1(C)

- V. LEONARDO OFFICINA ITALIANA IS NOT USED WITHIN INTERSTATE COMMERCE BEFORE THE FEDERAL APPLICATION WAS FILED WITH THE USPTO AND NO AMENDMENT TO ALLEGE USE WAS FILED
- 22. Upon information and belief, Applicant has not used Applicant's Applied-For Mark within interstate commerce in connection with ALL of its identified goods as stated in Application Serial No. 79/247,573.
- 23. Upon information and belief, Applicant knew at the time it made the filings on December 13, 2018, that it had not used Applicant's Applied-For Mark within interstate commerce in connection with ALL of the goods identified in Application Serial No. 79/247,573.
 - 24. The USPTO has reasonably relied on the truth of such false basis of filing by Applicant.

- 25. Opposer expects that evidence showing further factual basis for these allegations is likely to be obtained after a reasonable possibility for discovery or investigation in this opposition proceeding.
- 26. Thus, Applicant committed fraud in its filing of Application Serial No. 79/247,573. *Bose Corp. v. Hexawave, Inc.*, Opposition No. 91157315, 2008 WL 1741913 (T.T.A.B. Apr. 9, 2008).

FIFTH CLAIM OF RELIEF UNDER MISUSE OF REGISTRATION SYMBOL

VI. APPLICANT IS EXPRESSLY MISUSING THE REGISTRATION SYMBOL IN RELATION TO ITS APPLIED-FOR MARK

- 27. As it can be seen in **Exhibit E**, Applicant also fraudulently places the registration ® next to Applicant's Mark on the container, when in fact, Applicant's Application Serial No. 79/247,573 is still pending with the USPTO. Applicant has not been given federal registration status by the USPTO. This is considered as unlawful use, and Applicant should lose its right to register Applicant's Mark with the USPTO. See *Fox-Stanly Photo Products, Inc. v. Otaguro*, 333 F.Supp. 1293 (where the Court held that misuse of notice of registration of a mark was unclean hands so as to bar registration).
- 28. The above usage and marking of the goods with a notice of registration by use of the registration symbol on the container by Applicant is a fraudulent misuse of Applicant's Applied-For Mark and subjects the mark to refusal to register.
- 29. The Trademark Manual of Examining Procedure at Section 902.03 provides that fraudulent intent and purpose in using a federal registration symbol is a basis for refusal of registration. Thus, Opposer believe that the pending application can be opposed for registration for the above reasons.

THEREFORE, it is respectfully requested that this Opposition be sustained and that the registration of Applicant's Applied-For Mark in Application Serial No. 79/247,573 be refused in its entirety.

Dated: January 27, 2020

Attorney for Opposer

NADKARNI LAW

By: /Kaustubh Nadkarni/

Kaustubh Nadkarni, Esq. 1900 N. Bayshore Drive, Unit 1A, Suite 140 Miami, FL 33132

Email: <u>ip@nadkarnilaw.com</u> www.nadkarnilaw.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing NOTICE OF OPPOSITION was served upon Applicant by delivering true and correct copies of same to Applicant's Attorney via Electronic Mail on January 27, 2020.

By: Kaustubh Nadkarni

NADKARNI LAW 1900 N. Bayshore Drive, Unit 1A, Suite 140 Miami, FL 33132

/Kaustubh Nadkarni/

Kaustubh Nadkarni

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 79247573

MARK: LEONARDO OFFICINA ITALIANA *79247573*

CORRESPONDENT ADDRESS:

DRESS: CLICK HERE TO RESPOND TO THIS
Ispira srl LETTER:

Via Piave, 205 http://w

I-80126 Napoli ITALY http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Ispira srl

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

INTERNATIONAL REGISTRATION NO. 1439398

STRICT DEADLINE TO RESPOND TO THIS NOTIFICATION: TO AVOID ABANDONMENT OF THE REQUEST FOR EXTENSION OF PROTECTION OF THE INTERNATIONAL REGISTRATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS PROVISIONAL FULL REFUSAL NOTIFICATION WITHIN 6 MONTHS OF THE "DATE ON WHICH THE NOTIFICATION WAS SENT TO WIPO (MAILING DATE)" LOCATED ON THE WIPO COVER LETTER ACCOMPANYING THIS NOTIFICATION.

In addition to the Mailing Date appearing on the WIPO cover letter, a holder (hereafter "applicant") may confirm this Mailing Date using the USPTO's Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. To do so, enter the U.S. application serial number for this application and then select "Documents." The Mailing Date used to calculate the response deadline for this provisional full refusal is the "Create/Mail Date" of the "IB-1rst Refusal Note."

This is a **PROVISIONAL FULL REFUSAL** of the request for extension of protection of the mark in the above-referenced U.S. application. *See* 15 U.S.C. §1141h(c). See below in this notification (hereafter "Office action") for details regarding the provisional full refusal.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Likelihood of Confusion Refusal

Registration of the applied-for mark is refused as to "pencil holders; stands for pens and pencils; drawing instruments; writing instruments" because of a likelihood of confusion with the mark in U.S. Registration No. 2875587. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 et seq. See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). A determination of likelihood of confusion under Section 2(d) is made on a case-by case basis and the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) aid in this determination. Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d 1344, 1349, 98 USPQ2d 1253, 1256 (Fed. Cir. 2011) (citing On-Line Careline, Inc. v. Am. Online, Inc., 229 F.3d 1080, 1085, 56 USPQ2d 1471, 1474 (Fed. Cir. 2000)).

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. In re White Swan Ltd., 8 USPQ2d 1534, 1535 (TTAB 1988); see In re 1st USA Realty Prof'ls, Inc., 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Applicant's mark is LEONARDO – Officina Italiana and Design . The mark in the cited registration is LEONARDO. The marks are similar in sound, appearance and meaning, sharing the dominant word LEONARDO. Applicant is required to disclaim the descriptive wording "OFFICINA ITALIANA" apart from the mark. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. Disclaimed matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) TMEP §1207.01(b)(viii), (c)(ii). Here the dominant non-disclaimed portion of applicant's mark is LEONARDO, which is identical to the mark in the cited registration.

Applicant's mark includes a design element. However, since the dominant word portions are identical in appearance, sound, connotation, and commercial impression, the addition of a design element does not obviate the similarity of the marks in this case. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

Comparison of the Goods

The goods of the parties need not be identical or even competitive to find a likelihood of confusion. See On-line Careline Inc. v. Am. Online Inc., 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); Recot, Inc. v. Becton, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods need only be "related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source." Coach Servs., Inc. v. Triumph Learning LLC, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting 7-Eleven Inc. v. Wechsler, 83 USPQ2d 1715, 1724 (TTAB 2007)); Gen. Mills Inc. v. Fage Dairy Processing Indus. SA, 100 USPQ2d 1584, 1597 (TTAB 2011); TMEP §1207.01(a)(i).

Applicant's refused goods are "pencil holders; stands for pens and pencils; drawing instruments; writing instruments" in Class 16. Registrant's goods are "Pencils" in Class 16. The goods are overlapping and identical in part because pencils are drawing and writing instruments. The remaining goods are closely related because pencil holders and stands are used together with pencils.

Since the respective marks are confusingly similar, and applicant's goods and the goods in the cited registration are closely related, purchasers of applicant's goods may mistakenly assume that the goods come from registrant, or that registrant and applicant are somehow related. Accordingly, there is a likelihood of confusion and registration must be refused under Section 2(d) of the Trademark Act.

Applicant may respond to the stated refusal by submitting evidence and arguments against the refusal. In addition, applicant may respond by doing one of the following:

- (1) Deleting the goods to which the refusal pertains;
- (2) Filing a request to divide out the goods that have not been refused registration, so that the mark may proceed toward publication for opposition for those goods or services to which the refusal does not pertain. See 37 C.F.R. §2.87. See generally TMEP §§1110 et seq. (regarding the requirements for filing a request to divide). If applicant files a request to divide, then to avoid abandonment, applicant must also file a timely response to all outstanding issues in this Office action, including the refusal. 37 C.F.R. §2.87(e).

If applicant responds to the refusal, applicant must also respond to the requirements set forth below.

Identification of Goods

The identification of goods and/or services contains parentheses. Generally, applicants should *not* use parentheses and brackets in identifications in their applications so as to avoid confusion with the USPTO's practice of using parentheses and brackets in registrations to indicate goods and/or services that have been deleted from registrations or in an affidavit of incontestability to indicate goods and/or services not claimed. *See* TMEP §1402.12. The only exception is that parenthetical information is permitted in identifications in an application if it serves to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity or scope of the identification, e.g., "fried tofu pieces (abura-age)." *Id.*

Therefore, applicant must remove the parentheses from the identification and incorporate any parenthetical or bracketed information into the description of the goods and/or services.

Translation Required

To permit proper examination of the application, applicant must submit an English translation of the foreign wording in the mark OFFICINA ITALALIANA. 37 C.F.R. §§2.32(a)(9), 2.61(b); *see* TMEP §809. The following English translation is suggested: **The English translation of "Officina Italiana" in the mark is "Italian Workplace".** TMEP §809.03. See attached translation evidence.

Disclaimer Required

Applicant must disclaim "OFFICINA" because it merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services, and thus is an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting In re Oppedahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); TMEP §§1213, 1213.03(a).

The attached evidence from shows this wording means "workplace" which i s commonly used in connection with office goods.

Applicant must also disclaim ITALIANA because, as shown by the attached evidence, it means ITALIAN and is primarily geographically descriptive of the origin of applicant's goods. *See* 15 U.S.C. §§1052(e)(2); *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1451-52 (Fed. Cir. 1987); TMEP §§1210.01(a), 1210.06(a), 1213.03(a). The goods for which applicant seeks registration originate in this geographic place or location as shown by applicant's address. *See* TMEP §1210.03. Because the goods originate in this place, a public association of the goods with the place is presumed. TMEP §§1210.02(a) 1210.04.

Applicant may respond to this issue by submitting a disclaimer in the following format:

No claim is made to the exclusive right to use "OFFICINA ITALIANA" apart from the mark as shown.

For an overview of disclaimers and instructions on how to satisfy this issue using the Trademark Electronic Application System (TEAS), see the <u>Disclaimer webpage</u>.

Mark Description

Applicant must submit a more concise description of the mark. 37 C.F.R. §2.37; see TMEP §§808 et seq. The following is suggested:

The mark consists of the word LEONARDO on the first line and OFFICINA ITALIANA on the second line and below is a design composed of four couples of wavy lines forming wings.

WHO IS PERMITTED TO RESPOND TO THIS PROVISIONAL FULL REFUSAL: Any response to this provisional refusal must be personally signed by an individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). 37 C.F.R. §§2.62(b), 2.193(e)(2)(ii); TMEP §712.01. If applicant hires a qualified U.S. attorney to respond on his or her behalf, then the attorney must sign the response. 37 C.F.R. §§2.193(e)(2)(i), 11.18(a); TMEP §§611.03(b), 712.01. Qualified U.S. attorneys include those in good standing with a bar of the highest court of any U.S. state, the District of Columbia, Puerto Rico, and other U.S. commonwealths or U.S. territories. *See* 37 C.F.R. §§2.17(a), 2.62(b), 11.1, 11.14(a); TMEP §§602, 712.01. Additionally, for all responses, the proper signatory must personally sign the document or personally enter his or her electronic signature on the electronic filing. *See* 37 C.F.R. §2.193(a); TMEP §§611.01(b), 611.02. The name of the signatory must also be printed or typed immediately below or adjacent to the signature, or identified elsewhere in the filing. 37 C.F.R. §2.193(d); TMEP §611.01(b).

In general, foreign attorneys are not permitted to represent applicants before the USPTO (e.g., file written communications, authorize an amendment to an application, or submit legal arguments in response to a requirement or refusal). *See* 37 C.F.R. §11.14(c), (e); TMEP §§602.03-.03(b), 608.01.

DESIGNATION OF DOMESTIC REPRESENTATIVE: The USPTO encourages applicants who do not reside in the United States to designate a domestic representative upon whom any notice or process may be served. TMEP §610; *see* 15 U.S.C. §§1051(e), 1141h(d); 37 C.F.R. §2.24(a)(1)-(2). Such designations may be filed online at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

/John M. Wilke/ Examining Attorney Law Office 104 571-272-5871 john.wilke@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For technical assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

Print: Dec 20, 2018 78167952

TYPED DRAWING

Serial Number

78167952

Status

REGISTERED AND RENEWED

Word Mark

LEONARDO

Standard Character Mark

No

Registration Number

2875587

Date Registered

2004/08/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

Montblanc-Simplo GmbH CORPORATION FED REP GERMANY Hellgrundweg 100 22525 Hamburg FED REP GERMANY

Goods/Services

Class Status -- ACTIVE. IC 016. US 002 005 022 023 029 037 038 050. G & S: Pencils. First Use: 2001/11/09. First Use In Commerce: 2001/11/09.

Filing Date

2002/09/25

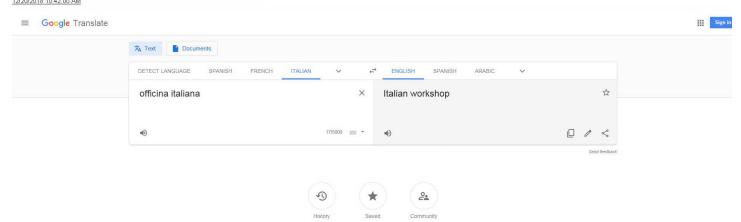
Examining Attorney

CLAYTON, CHERYL

Attorney of Record

Lawrence E. Apolzon

https://branslate.google.com/#wiew=home&op=translate&sl=it&tl=en&text=officina%20ttaliana 12/20/2018 10.42.00 AM



Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER 79247573	
LAW OFFICE ASSIGNED	LAW OFFICE 104
DATE OF NOTICE OF ABANDONMENT	08/15/2019
PETITION	
PETITION STATEMENT	Applicant has firsthand knowledge that the failure to respond to the Office Action by the specified deadline was unintentional, and requests the USPTO to revive the abandoned application.
RESPONSE TO OFFICE ACTION	
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/79247573/large
LITERAL ELEMENT	LEONARDO OFFICINA ITALIANA
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	Color is not claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	At the first line there is the "leonardo" writing, on the second line the writing "officina italiana". Below the written there is a drawing, place centrally. It is composed of four couples of wavy lines.
OWNER SECTION (current)	
NAME	Ispira srl
INTERNAL ADDRESS	Via Piave, 205
STREET	I-80126 Napoli
COUNTRY	Italy
OWNER SECTION (proposed)	
NAME	Ispira srl
STREET	Via Piave, 205
CITY	Napoli
ZIP/POSTAL CODE	I-80126
COUNTRY	Italy
EMAIL	jdefrancesco@hillwallack.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
LEGAL ENTITY SECTION (current)	
ТҮРЕ	limited liability company

STATE/COUNTRY WHERE LEGALLY ORGANIZED	Italy
LEGAL ENTITY SECTION (proposed)	
ТУРЕ	società a responsabilità limitata (srl)
STATE/COUNTRY WHERE LEGALLY ORGANIZED	Italy

ARGUMENT(S)

Applicants refused goods are pencil holders; stands for pens and pencils; drawing instruments; writing instruments in Class 16. Applicant hereby responds to the stated refusal by deleting the goods to which the refusal pertains and respectfully requests the application be allowed to publish.

GOODS AND/OR SERVICES SECTION (current)

DESCRIPTION

Writing cases (stationery); drawing pads; inkwells; pen clips; cabinets for stationery (office requisites); paperweights; staples for offices; rubber erasers; ink; Indian inks; pastels (crayons); nibs; nibs of gold; pens (office requisites); balls for ball-point pens; steel pens; pencil holders; pen cases; erasing products; writing or drawing books; inkstands; balls for ball-point pens; stands for pens and pencils; fountain pens; drawing instruments; writing instruments; note books

GOODS AND/OR SERVICES SECTION (proposed)

INTERNATIONAL CLASS

016

6

TRACKED TEXT DESCRIPTION

Writing cases (stationery); Writing cases, being stationery; drawing pads; inkwells; pen clips; eabinets for stationery (office requisites); cabinets for stationery being office requisites; staples for offices; rubber erasers; ink; Indian inks; pastels, namely, crayons; pastels (erayons); nibs; nibs of gold; pens being office requisites; pens (office requisites); paperweights; balls for ball-point pens; steel pens; pencil holders; penholders; pen cases; erasing products; writing or drawing books; inkstands; fountain pens; balls for ball-point pens; note books; stands for pens and pencils; drawing instruments; writing instruments

FINAL DESCRIPTION

Writing cases, being stationery; drawing pads; inkwells; pen clips; cabinets for stationery being office requisites; staples for offices; rubber erasers; ink; Indian inks; pastels, namely, crayons; nibs; nibs of gold; pens being office requisites; paperweights; balls for ball-point pens; steel pens; penholders; pen cases; erasing products; writing or drawing books; inkstands; fountain pens; note books

ADDITIONAL STATEMENTS SECTION

DESCRIPTION OF THE MARK (and Color Location, if applicable)		No claim is made to the exclusive right to use "OFFICINA ITALIANA" apart from the mark as shown.
		The mark consists of the word LEONARDO on the first line and OFFICINA ITALIANA on the second line and below is a design composed of four couples of wavy lines forming wings.
	TRANSLATION	The English translation of "Officina Italiana" in the mark is "Italian Workplace".

ATTORNEY SECTION (new)

ATTORIVET SECTION (IICW)		
NAME	Jason L DeFrancesco	
ATTORNEY BAR MEMBERSHIP NUMBER	XXX	
YEAR OF ADMISSION	XXXX	
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX	
FIRM NAME	Hill Wallack LLP	
STREET	21 Roszel Rd.	
СІТУ	Princeton	
STATE	New Jersey	

POSTAL CODE	08540	
COUNTRY	United States	
EMAIL	jdefrancesco@hillwallack.com	
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes	
CORRESPONDENCE SECTION (current)		
NAME	Ispira srl	
STREET	Via Piave, 205	
CITY	Napoli	
POSTAL CODE	80126	
COUNTRY	IT	
PHONE	+393386390000	
EMAIL	ispira.doc@gmail.com; sales@leonardopen.com	
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes	
CORRESPONDENCE SECTION (proposed)		
NAME	Jason L DeFrancesco	
FIRM NAME	Hill Wallack LLP	
STREET	21 Roszel Rd.	
СІТУ	Princeton	
STATE	New Jersey	
POSTAL CODE	08540	
COUNTRY	United States	
EMAIL	jdefrancesco@hillwallack.com; ipdocket@hillwallack.com	
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes	
PAYMENT SECTION		
TOTAL AMOUNT	100	
TOTAL FEES DUE	100	
SIGNATURE SECTION		
PETITION SIGNATURE	/Jason DeFrancesco/	
SIGNATORY'S NAME	Jason DeFrancesco	
SIGNATORY'S POSITION	Attorney of Record, DC Bar member	
DATE SIGNED	10/04/2019	
RESPONSE SIGNATURE	/Jason DeFrancesco/	
SIGNATORY'S NAME	Jason DeFrancesco	
SIGNATORY'S POSITION	Attorney of record, DC bar member	
DATE SIGNED	10/04/2019	
AUTHORIZED SIGNATORY	YES	
FILING INFORMATION SECTION		
SUBMIT DATE	Fri Oct 04 16:56:59 EDT 2019	

TEAS STAMP	USPTO/POA-XX.XXX.XXX.XXX-2 0191004165659804980-79247 573-6103476d6a75a84f60774 8a5155952898de0a87abfbb43 5eaffea82b8a22558c39-DA-5 6599025-20191004164503005
	863

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 2194 (Rev 03/2012)

OMB No. 0651-0054 (Exp 12/31/2020)

Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action To the Commissioner for Trademarks:

Application serial no. **79247573** LEONARDO OFFICINA ITALIANA (Stylized and/or with Design, see https://tmng-al.uspto.gov/resting2/api/img/79247573/large) has been amended as follows:

PETITION

Petition Statement

Applicant has firsthand knowledge that the failure to respond to the Office Action by the specified deadline was unintentional, and requests the USPTO to revive the abandoned application.

RESPONSE TO OFFICE ACTION

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicants refused goods are pencil holders; stands for pens and pencils; drawing instruments; writing instruments in Class 16. Applicant hereby responds to the stated refusal by deleting the goods to which the refusal pertains and respectfully requests the application be allowed to publish.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 016 for Writing cases (stationery); drawing pads; inkwells; pen clips; cabinets for stationery (office requisites); paperweights; staples for offices; rubber erasers; ink; Indian inks; pastels (crayons); nibs; nibs of gold; pens (office requisites); balls for ball-point pens; steel pens; pencil holders; pen cases; erasing products; writing or drawing books; inkstands; balls for ball-point pens; stands for pens and pencils; fountain pens; drawing instruments; writing instruments; note books
Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: Writing cases (stationery); Writing cases, being stationery; drawing pads; inkwells; pen clips; eabinets for stationery (office requisites); cabinets for stationery being office requisites; staples for offices; rubber erasers; ink; Indian inks; pastels, namely, crayons; pastels (crayons); nibs; nibs of gold; pens being office requisites; pens (office requisites); paperweights; balls for ball-point pens; steel pens; pencil holders; pen cases; erasing products; writing or drawing books; inkstands; fountain pens; balls for ball-point pens; note books; stands for pens and pencils; drawing instruments; writing instruments

Class 016 for Writing cases, being stationery; drawing pads; inkwells; pen clips; cabinets for stationery being office requisites; staples for offices; rubber erasers; ink; Indian inks; pastels, namely, crayons; nibs; nibs of gold; pens being office requisites; paperweights; balls for ball-point pens; steel pens; penholders; pen cases; erasing products; writing or drawing books; inkstands; fountain pens; note books

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

APPLICANT AND/OR ENTITY INFORMATION

Applicant proposes to amend the following:

Current: Ispira srl, a limited liability company legally organized under the laws of Italy, having an address of

Via Piave, 205I-80126 Napoli

Italy

Proposed: Ispira srl, società a responsabilità limitata (srl) legally organized under the laws of Italy, having an address of

Via Piave, 205 Napoli, I-80126 Italy jdefrancesco@hillwallack.com (authorized)

The applicant hereby appoints Jason L DeFrancesco. Jason L DeFrancesco of Hill Wallack LLP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, is located at

21 Roszel Rd. Princeton, New Jersey 08540 United States

to submit this Petition To Revive Abandoned Application - Failure To Respond Timely To Office Action on behalf of the applicant.

The email address is jdefrancesco@hillwallack.com

Jason L DeFrancesco submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

The applicant's current correspondence information: Ispira srl. Ispira srl, is located at

Via Piave, 205 Napoli, 80126 IT

The phone number is +393386390000.

The email address is ispira.doc@gmail.com; sales@leonardopen.com

The applicants proposed correspondence information: Jason L DeFrancesco. Jason L DeFrancesco of Hill Wallack LLP, is located at

21 Roszel Rd. Princeton, New Jersey 08540 United States

 $The\ email\ address\ is\ jdefrancesco@hillwallack.com;\ ipdocket@hillwallack.com$

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use "OFFICINA ITALIANA" apart from the mark as shown.

Description of mark

The mark consists of the word LEONARDO on the first line and OFFICINA ITALIANA on the second line and below is a design composed of four couples of wavy lines forming wings.

Translation

The English translation of "Officina Italiana" in the mark is "Italian Workplace".

FEE(S)

Fee(s) in the amount of \$100 is being submitted.

SIGNATURE(S)

Signature: /Jason DeFrancesco/ Date: 10/04/2019

Signatory's Name: Jason DeFrancesco

Signatory's Position: Attorney of Record, DC Bar member

Response Signature

Signature: /Jason DeFrancesco/ Date: 10/04/2019

Signatory's Name: Jason DeFrancesco

Signatory's Position: Attorney of record, DC bar member

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: Ispira srl

Via Piave, 205 Napoli, 80126 Mailing Address: Jason L DeFrancesco

Hill Wallack LLP 21 Roszel Rd.

Princeton, New Jersey 08540

RAM Sale Number: 79247573 RAM Accounting Date: 10/04/2019

Serial Number: 79247573

Internet Transmission Date: Fri Oct 04 16:56:59 EDT 2019

TEAS Stamp: USPTO/POA-XX.XXX.XXX.XXX-2019100416565980

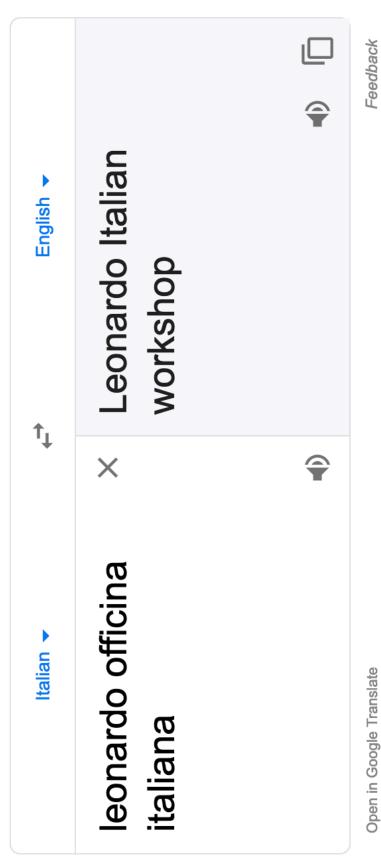
4980-79247573-6103476d6a75a84f607748a515 5952898de0a87abfbb435eaffea82b8a22558c39 -DA-56599025-20191004164503005863

RAM SALE NUMBER: 79247573 RAM ACCOUNTING DATE: 20191004

INTERNET TRANSMISSION DATE: SERIAL NUMBER:

2019/10/04 79/247573

Description	Fee Code	Transaction	Total Fees Paid
POA	7005	2019/10/04	100



Open in Google Translate

REQUEST FOR EXTENSION OF PROTECTION

SERIAL NUMBER: 79247573

FILING DATE: 06/28/2018

The table below presents the data as entered.

-				
Input Field	Entered			
MARK SECTION				
IMAGE	$\ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ \ $			
COLLECTIVE, CERTIFICATE OR GUARANTEE MARK	NO			
MARK IN STANDARD CHARACTERS	NO			
MARK IN COLOR	NO			
THREE DIMENSIONAL MARK	NO			
SOUND MARK	NO			
VERBAL ELEMENTS OF THE MARK	Leonardo Officina Italiana			
MARK DESCRIPTION	At the first line there is the "leonardo" writing, on the second line the writing "officina italiana". Below the written there is a drawing, place centrally. It is composed of four couples of wavy lines.			
TM IMAGE: COLOR	NO			
IMAGE FILE NAME	$\verb \TICRS\EXPORT17\IMAGEOUT17\792\475\79247573\xml1\APP0002.JPG $			
TYPE (IMAGE TYPE)	JPG			
TEXTUAL ELEMENTS OF MARK	LEONARDO OFFICINA ITALIANA			
HOLDER DETAILS				
CLIENT IDENTIFIER	1130272			
NOTIFICATION LANGUAGE	ENGLISH			
NAME	Ispira srl			
ADDRESS	Via Piave, 205			
	I-80126 Napoli			
COUNTRY	Italy			
ENTITLEMENT ESTABLISHMENT	Italy			
LEGAL NATURE	limited liability company Ltd			
LEGAL NATURE: PLACE INCORPORATED	Italy			
CORRESPONDENCE INDICATOR	YES			
LIMITATION DETAILS				
DESIGNATED CONTRACTING PARTY CODE	United States of America			
GOODS AND SERVICES (HEADER)	List limited to class 16.			
BASIC GOODS AND SERVICES				
VERSION OF NICE CLASSIFICATION USED	11-2018			
NICE CLASSIFICATION	14			

GOODS AND SERVICES

Rings [jewelry]; bracelets made of embroidered textile [jewellery]; watch bands; cabochons; clock cases; watch cases [parts of watches]; jewellery charms; cuff links; lockets [jewelry]; precious metals, unwrought or semi-wrought; watches; watch cases [parts of watches]; presentation boxes for jewelry; jewelry rolls; pins [jewelry]; key rings [split rings with trinket on silver, unwrought or beaten]; clasps for jewelry; necklaces [jewelry]; chronometers; clock hands.

NICE CLASSIFICATION

GOODS AND SERVICES

Writing cases [stationery]; drawing pads; inkwells; pen clips; cabinets for stationery [office requisites]; paperweights; staples for offices; rubber erasers; ink; Indian inks; pastels [crayons]; nibs; nibs of gold; pens [office requisites]; balls for ball-point pens; steel pens; pencil holders; penholders; pen cases; erasing products; writing or drawing books; inkstands; balls for ball-point pens; stands for pens and pencils; fountain pens; drawing instruments; writing instruments; note books.

BASE REGISTRATION DETAILS

BASE REGISTRATION NUMBER 302017000046208

BASE REGISTRATION DATE 03/09/2018

INTENT TO USE GROUP

CONTRACTING PARTY CODE United States of America

DESIGNATIONS

DESIGNATIONS UNDER THE PROTOCOL United States of America

INTERNATIONAL REGISTRATION DETAILS

INTERNATIONAL REGISTRATION NUMBER 1439398 INTERNATIONAL REGISTRATION DATE OF 06/28/2018 MARK INTERNATIONAL REGISTRATION EXPIRY DATE 06/28/2028 EFFECTIVE DATE OF MODIFICATION 06/28/2018 NOTIFICATION DATE 12/13/2018 DATE OF RECORDAL IN INTERNATIONAL 11/30/2018 REGISTER IB DOCUMENT ID 1177374101

OFFICE OF ORIGIN CODE Italy

OFFICE REFERENCE 79247573

TRANSACTION TYPE VALUES **Initial Designation**

ORIGINAL LANGUAGE **ENGLISH**

INSTRUMENT UNDER WHICH CONTRACTING

Protocol PARTY IS DESIGNATED

10 **DURATION OF MARK (YEARS)**

VIENNA CLASSIFICATION VERSION USED

VIENNA CLASS 0307 VIENNA CLASS 2611 VIENNA CLASS 2705

LEONARDO OFFICINA ITALIANA







handmade in ITALY, only and exclusively in the Italian workshops Leonardo

#leonardopen #leonardoofficinaitaliana #stilografica #italianpen #penna





LEONARDO OFFICINA ITALIANA®

... More than 45 years of experience, from father to son. And the story goes on...



Happy Fountain pen day to all our friends!
#fountainpenday #stilografica #fountainpen #leonardopen #italianpen
#pencollector

